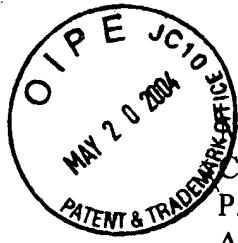


JCN
AF/16/08
28

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 17, 2004

(Date of Deposit)

James D. Wood

Name of person mailing Document or Fee

Signature

May 17, 2004

Date of Signature

Re: Application of: Wike et al.
Serial No.: 10/001,389
Filed: October 23, 2001
For: Automatic Electronic Article
Surveillance for Self-Checkout
Group Art Unit: 2876
Examiner: Uyen-Chau N Le
Our Docket No.: 9423 (1001-0728)

TRANSMITTAL OF BRIEF ON APPEAL

Please find for filing in connection with the above patent application the following documents:

1. Original of the Brief on Appeal on Appeal;
2. Three (3) copies of the Brief on Appeal;
3. A Check in the amount of \$330.00; and
4. One (1) return post card.

Commissioner for Patents
May 17, 2004
Page 2

Please charge any fee deficiency or credit any overpayment to Deposit Account No. 13-0014.

Respectfully Submitted,

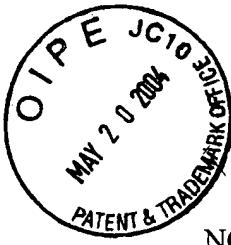
MAGINOT, MOORE & BECK



May 17, 2004

James D. Wood
Registration No. 43,285
Bank One Center/Tower
111 Monument Circle, Suite 3000
Indianapolis, IN 46204-5115

Enclosures



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

NCR Docket No. 9423

MMB Docket No. 1001-0728

Application of: Wike et al.

Group Art Unit: 2876

Serial No. 10/001,389

Examiner: Uyen-Chau N Le

Filed: October 23, 2001

For: Automatic Electronic Article Surveillance for Self-Checkout

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 17, 2004

(Date of Deposit)

James D. Wood

Name of person mailing Document or Fee

Signature of person mailing Document or Fee

May 17, 2004

Date of Signature

BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal under 37 CFR § 1.191 to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office from the final rejection of the claims 1-20 of the above-identified patent application. These claims were indicated as finally rejected in an Office Action dated December 16, 2003. Three copies of the

brief are filed herewith, together with the \$330.00 fee required under 37 CFR § 1.17(c).

Also, please provide any extensions of time that may be necessary and charge any fees that may be due to Account No. 13-0014, but not to include any payment of issue fees.

(1) REAL PARTY IN INTEREST

NCR Corporation of Dayton, Ohio is the assignee of this patent application, and the real party in interest.

(2) RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this patent application (serial no. 10/001,389).

(3) STATUS OF CLAIMS

Claims 1-20 are pending in the application.

Claims 1-20 are finally rejected.

Claims 1-20 are being appealed, and are shown in the Appendix attached to this Appeal Brief.

(4) STATUS OF AMENDMENTS

Appellants have filed no amendments subsequent to the final rejection contained in the Office Action mailed December 16, 2003.

(5) SUMMARY OF INVENTION

In summary, Applicants' invention is a retail terminal, such as a self-service or checkout retail terminal (SCOT), and a method of operation thereof. The retail terminal includes an electronic article surveillance (EAS) system. The EAS system includes an EAS detector and an EAS deactivator. (See, e.g., Appellants' specification at page 11, lines 18-19 and at page 12, lines 15-16.) The EAS detector, which may be associated with a scanner, is operative to detect an EAS tag on an item. (See, e.g., Appellants' specification at page 11, lines 18-19.) In one non-limiting embodiment, the EAS detector is a coil and electronic circuitry and may be provided as an add-on or module. (See, e.g., Appellants' specification at page 12, lines 4-6 and page 25, lines 9-11.) The EAS deactivator is operative to deactivate an EAS tag.

In one non-limiting example, a self-checkout includes a processor operably connected to a scanner, an EAS detector, an EAS deactivator, and a memory that is operably connected to the processor. (See, e.g., Appellants' specification at page 19, line 11 through page 20, line 4 and FIG. 3.)

In accordance with one embodiment of the invention, a second EAS detector is located proximate the bagwell or security scale. (See, e.g., Appellants' specification at page 23, line 9 through page 24, line 18.) The second EAS detector may be used to double check whether or not a tag authorized to be deactivated has in fact been deactivated. (See, e.g., Appellants' specification at page 24, lines 11-15.)

According to one method, a customer scans an item. (See, e.g., Appellants' specification at page 27, lines 21-22 and FIG. 9.) During or after the scanning of the item, a detector senses whether or not the item has an EAS tag. (See, e.g., Appellants'

specification at page 27, lines 22-23.) If the item has an EAS tag, the customer is directed to deactivate the EAS tag. (See, e.g., Appellants' specification at page 28, lines 2-3.) After deactivating or attempting to deactivate the EAS tag, the customer places the item into the bagwell, where a second detector checks to verify that the authorized deactivation has occurred. (See, e.g., Appellants' specification at page 28, lines 4-7.)

(6) ISSUES

Whether claims 1-4, 8-9 and 15-16 are unpatentable under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,594,228 to Swartz et al. (hereinafter "Swartz") in view of U.S. Patent No. 5,469,142 to Bergman et al. (hereinafter "Bergman").

Whether claims 5-7, 10-12 and 17-19 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Swartz as modified by Bergman in further view of U.S. Pre-Grant Publication No. US 2002/0,096,564 A1 of Bellis, Jr. et al. (hereinafter "Bellis").

Whether claims 13-14 and 20 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Swartz as modified by Bergman in further view of U.S. Patent No. 6,486,780 B1 to Garber et al. (hereinafter "Garber").

(7) GROUPING OF CLAIMS

The claims do not all stand or fall together.

Claims 1-3 form a first separately patentable group which is argued independently of the other claims for purposes of this appeal.

Claim 4 forms a second separately patentable group which is argued independently of the other claims for purposes of this appeal.

Claims 5-7 form a third separately patentable group which is argued independently of the other claims for purposes of this appeal.

Claims 8-9 and 13-14 form a fourth separately patentable group which is argued independently of the other claims for purposes of this appeal.

Claims 10-12 form a fifth separately patentable group which is argued independently of the other claims for purposes of this appeal.

Claims 15-16 and 20 form a sixth separately patentable group which is argued independently of the other claims for purposes of this appeal.

Claims 17-19 form a seventh separately patentable group which is argued independently of the other claims for purposes of this appeal.

(8) ARGUMENT

First Claim Grouping: **Claims 1-3 are Not Unpatentable Over the Prior Art**

Discussion re: Patentability of Claim 1

1. Claim 1

Claim 1 stands rejected as allegedly being obvious over Swartz in view of Bergman. Claim 1 includes the following limitations:

A method of operating a self-service checkout terminal comprising the steps of:
allowing consumer scanning of an item for purchase via a scanner;
determining, after successfully scanning the item, whether the item has an active electronic article surveillance tag; and
allowing deactivation of the active electronic article surveillance tag by the consumer via an active electronic article surveillance tag deactivator after determining that the item has an electronic article surveillance tag.

Thus, after an item is scanned, a determination is made as to whether or not the

item has an EAS tag associated with it. If the item has an EAS tag, the customer is allowed to deactivate the EAS tag for the scanned item.

2. No Motivation to Combine References

The Examiner has utilized Swartz as a main reference for teaching a self-checkout having a scanner, an electronic article surveillance deactivator, a processor and a memory. It is then admitted by the Examiner that “Swartz et al fails to teach or fairly suggest that the system further comprising [sic] an electronic article surveillance detector operative to detect whether a scanned item has an active electronic article surveillance tag, wherein the electronic article surveillance detector is associated with the scanner”. (12/16/03 Office Action, page 3, first paragraph). The Examiner then cites to Bergman for teaching “an article surveillance detector for determining whether an active electronic article surveillance tag is present at the checkout station”. (Id. at page 3, second paragraph).

One of ordinary skill in the art would not be motivated to combine the teachings of Bergman with Swartz, since there is no need for the self-check apparatus of Swartz to ever incorporate a Bergman active electronic surveillance tag detector. The invention of Swartz is directed to “reading [bar code symbols] on surveillance tags removably mounted on the articles”. (Swartz at column 1, lines 23-25, see also Id. at column 18, lines 8-14). Thus, each surveillance tag is uniquely identified by a bar code that can be optically scanned. (Id. at column 18, lines 10-13). Accordingly, prior to allowing removal or deactivation of the surveillance tag, the system of Swartz uses the optical

code on the surveillance tag to verify that the item on which the tag is located has been scanned by the customer. (Id. at column 22, lines 20-30).

Swartz thus presumes not only that a surveillance tag is present, but also that the surveillance tag is uniquely identified by a bar code symbol that can be optically scanned. Because Swartz is providing an apparatus specifically for processing articles already known to have a security tag, it would be pointless to provide the Swartz self-check apparatus with a security tag detector (i.e. an electronic article surveillance tag detector). Thus, although Bergman utilizes an electronic article surveillance tag detector, one skilled in the art would not be motivated to combine Bergman with Swartz because there is no teaching or suggestion for the combination.

In response to the above argument raised by the Applicants in the Amendment filed September 25, 2003, the Examiner pointed to the symbol 128 and, claiming to give the broadest *reasonable* interpretation, maintained that the symbol 128 was being scanned, and not the surveillance tag. (See 12/16/03 Office Action, page 5, last paragraph *et seq.*). To the extent the Examiner intended to state that a label need not be associated with a surveillance tag, the Examiner's interpretation is not reasonable. As explicitly stated at numerous points in Swartz, the symbol 128 "identifies the [surveillance tag] and is preferably printed on the tag itself, or on a label permanently adhered to the tag." (Swartz at column 18, lines 10-13, see also column 18, lines 63-66, column 19, lines 4-5, column 19, lines 65-67, column 20, lines 48-59, column 21, lines 13-17, etc.). The broadest *reasonable* interpretation is that the symbol 128 uniquely identifies a particular surveillance tag. Accordingly, each item scanned by the system of Swartz *has* a surveillance tag. (See also id. at FIGs. 9A-12B and discussion at columns

19-24, wherein the described methods simply cannot work if there is no surveillance tag associated with the scanned symbol).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Clearly, one skilled in the art would not be motivated to provide a piece of equipment (i.e. the Bergman electronic article surveillance tag detector) along with another piece of equipment (i.e. the Swartz self-check apparatus) when adding the piece of equipment would be superfluous or of no use to the other piece of equipment.

Accordingly, there is no teaching or suggestion to one skilled in the art to combine Bergman with Swartz, and a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of claim 1. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 1.

3. The Proposed Combination Cannot Arrive at the Claimed Invention

As set forth above, claim 1 requires that a consumer be allowed to deactivate a surveillance tag *after* the step of determining whether or not a surveillance tag is present. This step cannot be performed when the device of Bergman is incorporated into the teaching of Swartz.

Bergman discloses an improved EAS tag deactivation system and apparatus. (Bergman at column 1, lines 65-67). The device of Bergman is initially operated at a low power. (Id. at column 3, lines 5-9). When an EAS tag is detected, the microprocessor in the device automatically proceeds to a deactivation process. (Id. at column 3, lines 12-

15, FIG. 3). Accordingly, once it is determined that a tag is on an item, the tag is deactivated. The consumer is not allowed to deactivate the EAS tag, since the device of Bergman has already deactivated the EAS tag. Simply stated, the devices taught by Swartz and the device taught by Bergman are *alternative* approaches, that exclude the use of the other device. Either the surveillance tag is detected and deactivated by the Bergman device, or the surveillance tag is scanned, verified to be associated with a scanned article, and then allowed to be deactivated by the Swartz device. In either event, a consumer is not allowed to deactivate a detected tag.

Accordingly, the proposed combination of Swartz and Bergman does not arrive at Appellants' invention of claim 1. Thus, the proposed combination of Swartz and Bergman does not establish a *prima facie* case of obviousness under 35 U.S.C. § 103 with regard to the invention defined in claim 1. As a result, claim 1 is allowable over Swartz and Bergman. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 1.

4. The Proposed Combination Changes Principle of Operation of Swartz

As explained above, the device of Swartz and the device of Bergman are alternative use devices. Although the Examiner was not clear in stating how Swartz was to be modified, to the extent the Examiner intended to replace the scanner/deactivator of Swartz with the detector/deactivator of Bergman, such modification impermissibly requires a change in the principle of operation of the invention of Swartz.

As explained above, Swartz is directed to optically detecting a bar code or other symbol that is located on a surveillance tag. Thus, the type of tag, whether laser

activated, radio frequency based, semiconductor diode based, or any other type surveillance tag, is irrelevant to the usefulness of the Swartz device. (See e.g. description of tags at column 8, line 47 through column 10, line 22, and discussion at column 10 lines 29-31). For any type of tag, the same optical scanner can be used to identify the symbol on the tag, and to thus uniquely identify the surveillance tag. (Id. at column 10, line 55 through column 11, line 10). In contrast, Bergman “detects” the surveillance tag by using a receiver that is initially set at a low gain. (Bergman at column 2, lines 55-62). The device of Bergman is thus based upon radio frequency (RF) detection.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The principle of RF detection of a surveillance tag is different from the principle of optically scanning a bar code. Accordingly, the combination proposed by the Examiner impermissibly changes the principle of operation of Swartz. Therefore, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 1.

5. The Proposed Combination Renders Swartz Inoperative

As noted above, the nature of the Examiner’s proposed modification of Swartz is not clear. Regardless, the proposed modification must either include 1) replacing the device of Swartz with the device of Bergman, or 2) using the device of Bergman before the device of Swartz is used (otherwise, there can be no “detection”, since the device of

Swartz deactivates the tag). In either event, such modification renders Swartz inoperable for its intended purpose.

As discussed above, the invention of Swartz is directed to an optical scanner that scans a code on a surveillance tag to uniquely identify the tag. After the tag is identified, Swartz ensures that the item to which the tag is attached has been properly purchased. (Swartz at column 20, lines 5-13). Only if the item has been properly purchased is deactivation of the tag allowed. (Id. at column 20, lines 14-16). If the Bergman device is used before the Swartz device, then the Bergman device deactivates the tag *before* it can be optically scanned and Swartz is inoperative for its intended purpose of verifying the optical code *prior* to allowing deactivation. If the Bergman device replaces the Swartz device, then there is no optical scanning whatsoever.

Because the proposed modification renders Swartz unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 1.

6. Conclusion as to Claim 1

Therefore, for all of the above reasons, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 1.

Discussion re: Patentability of Claims 2 and 3

Claims 2 and 3 also stand rejected as allegedly being obvious over Swartz in view of Bergman. Claims 2 and 3 depend, either directly or by way of an intermediate claim, from and incorporate all of the limitations of claim 1. Accordingly, for at least the same reasons as those set forth above in connection with claim 1, it is respectfully submitted that claims 2 and 3 are patentable over the prior art.

Second Claim Grouping: Claim 4 is Not Unpatentable Over the Prior Art

Discussion re: Patentability of Claim 4

1. Claim 4

Claim 4 stands rejected as allegedly being obvious over Swartz in view of Bergman. Claim 4 includes the following limitations:

The method of claim 1, further comprising the step of determining whether the electronic article surveillance tag has been deactivated after the step of allowing deactivation of the active electronic article surveillance tag after determining that the item includes the electronic article surveillance tag.

Claim 4, in addition to the steps of claim 1, includes the step of determining whether or not the tag has been deactivated.

2. The Proposed Combination Requires Extensive Redesign/Reprogramming

While the Examiner has failed to state where in the cited art the limitation added by claim 4 may be found, Bergman does disclose a double checking of a tag after deactivation of the tag. As discussed above, the device of Bergman initially detects a tag and then automatically deactivates the tag. The device of Bergman then increases the sensitivity of the receiver used to initially detect the tag, and double checks to ensure that

a tag intended to be deactivated has in fact been deactivated. (Bergman at column 3, lines 33-36).

However, it is not clear how the Examiner proposes to modify the teachings of Swartz and Bergman, so as to allow for the additional function of double checking. Regardless, such additional redesign and/or reprogramming of the prior art adds a layer of complexity to whatever redesign and/or reprogramming of the prior art the Examiner espouses with respect to arriving at the inventions of claims 1-3. Such substantial redesign and/or reprogramming shows that there is no suggestion or motivation to make the proposed modification. *In re Ratti*, 270 F.2d 810, 813, (CCPA 1959). Therefore, the Examiner has failed to provide a *prima facie* case of obviousness with respect to claim 4. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 4.

3. Conclusion as to Claim 4

Therefore, for all of the above reasons, as well as the reasons set forth with respect to claim 1 above, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 4.

Third Claim Grouping: Claims 5-7 are Not Unpatentable Over the Prior Art

Discussion re: Patentability of Claim 5

1. Claim 5

Claim 5 stands rejected as allegedly being obvious over Swartz in view of Bergman and in further view of Bellis. Claim 5 includes the following limitations:

The method of claim 4, wherein the step of determining whether the electronic article surveillance tag has been deactivated includes the step of utilizing a second electronic article surveillance detector.

Claim 5, in addition to the steps of claim 4, includes the step of using a second EAS detector when performing the step of determining whether or not the tag that is allowed to be deactivated, has been deactivated.

2. The Examiner's Line of Reasoning is Not Convincing

As discussed above with respect to claim 4, the device of Bergman detects the surveillance tag, deactivates the tag, and then increases receiver sensitivity in order to verify that the intended deactivation has occurred. In the event the intended deactivation has not occurred, the device of Bergman either alerts the customer or attempts to deactivate the tag again. (See e.g. Bergman at FIGs. 3 and 4A-B). Thus, a second detector is not needed. In fact, Bergman teaches that a second detector “is manifestly inefficient in requiring additional equipment and space consumption at the checkout station.” (Id. at column 1, lines 48-53). Accordingly, the device of Bergman is intended to eliminate the need for a second detector. (Id. at column 2, lines 1-3).

To provide a convincing line of reasoning for the combination of Bellis with Swartz and Bergman, the Examiner would either need to show that 1) Bergman fails in its

intended purpose, thus requiring a second detector, or 2) an artisan of ordinary skill in the art would be motivated to include a second detector along with the device of Bergman, knowing the second detector would not be used. The Examiner has failed to provide either line of reasoning.¹ Because the Examiner has failed to provide a convincing line of reasoning as required by MPEP § 2144, citing to *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985), the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 5.

3. Conclusion as to Claim 5

Therefore, for all of the above reasons, as well as the reasons set forth with respect to claim 4 above, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 5.

Discussion re: Patentability of Claims 6-7

Claims 6-7 also stand rejected as allegedly being obvious over Swartz in view of Bergman and in further view of Bellis. Claims 6-7 depend from and incorporate all of the limitations of claim 5. Accordingly, for at least the same reasons as those set forth above in connection with claim 5, it is respectfully submitted that claims 6-7 are patentable over the prior art. Accordingly, the Board of Appeals is respectfully requested

¹ The Examiner has provided a line of reasoning that a second detector would be included for the purpose of ensuring that “unpaid/unauthorized” items were not accidentally or intentionally removed from the store. (12/16/03 Office Action at page 4). However, the step of claim 4, to which claim 5 adds an additional limitation, is solely directed to checking a tag that *has been authorized for deactivation*. Accordingly, the Examiner’s “unpaid/unauthorized” line of reasoning is irrelevant.

to reverse the rejection of claims 6-7.

Fourth Claim Grouping: Claims 8-9 and 14 are Not Unpatentable Over the Prior Art

Discussion re: Patentability of Claim 8

1. Claim 8

Claim 8 stands rejected as allegedly being obvious over Swartz in view of Bergman. Claim 8 includes the following limitations:

A self checkout comprising:
 a scanner operative to scan an item;
 an electronic article surveillance detector operative to detect whether a successfully scanned item has an active electronic article surveillance tag; and
 an electronic article surveillance deactivator operative to deactivate the active electronic article surveillance tag after determining by the electronic article surveillance detector that a scanned item has the active electronic article surveillance tag.

As is germane to the present discussion, claim 8 differs from claim 1 in that claim 8 does not include a limitation related to allowing a customer to deactivate an EAS tag after detecting the presence of the tag. Accordingly, claim 8 is allowable over the prior art for all of the reasons set forth above with respect to claim 1, with the exception of the argument related to the arrival at the invention of claim 1 using the combination of Swartz and Bergman as set forth in paragraph number 3 under the discussion of claim 1. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 8.

Discussion re: Patentability of Claims 9 and 13-14

Claim 9 also stands rejected as allegedly being obvious over Swartz in view of

Bergman. Claims 13-14 stand rejected as allegedly being obvious over Swartz in view of Bergman and in further view of Garber. Claims 9 and 13-14 depend from and incorporate all of the limitations of claim 8, either directly or through an intermediate claim. Accordingly, for at least the same reasons as those set forth above in connection with claim 8, it is respectfully submitted that claims 9 and 13-14 are patentable over the prior art. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claims 9 and 13-14.

Fifth Claim Grouping: Claims 10-12 are Not Unpatentable Over the Prior Art

Discussion re: Patentability of Claim 10

1. Claim 10

Claim 10 stands rejected as allegedly being obvious over Swartz in view of Bergman and in further view of Bellis. Claim 10 includes the following limitations:

The self checkout of claim 8, further comprising a second electronic article surveillance detector that is operative to determine whether the electronic article surveillance tag has been deactivated by the electronic article surveillance deactivator.

Claim 10 thus includes all of the limitations of claim 8, and adds a limitation directed to a second EAS detector. The second EAS detector limitation is similar to the limitation discussed above with respect to claim 5. Accordingly, for all the reasons set forth above with respect to claim 8, as well as the reason discussed above specific to claim 5, it is respectfully submitted that claim 10 is patentable over the prior art. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claim 10.

Discussion re: Patentability of Claims 11-12

Claims 11-12 also stand rejected as allegedly being obvious over Swartz in view of Bergman and in further view of Bellis. Claims 11-12 depend from and incorporate all of the limitations of claim 10. Accordingly, for at least the same reasons as those set forth above in connection with claim 10, it is respectfully submitted that claims 11-12 are patentable over the prior art. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claims 11-12.

Sixth Claim Grouping: Claims 15-16 and 20 are Not Unpatentable Over the Prior Art

Discussion re: Patentability of Claim 15

1. Claim 15

Claim 15 stands rejected as allegedly being obvious over Swartz in view of Bergman. Claim 15 includes the following limitations:

A self checkout comprising:
a processor;
a scanner in communication with the processor;
an electronic article surveillance detector in communication with the processor;
an electronic article surveillance deactivator; and
a memory in communication with the processor and storing program instructions which, when executed by the processor, causes the processor to: (a) allow scanning of an item for purchase via the scanner, (b) determine, after successful scanning of the item, whether the item has an active electronic article surveillance tag via the electronic article surveillance detector, and (c) allow deactivation of the active electronic article surveillance tag after determining that the item includes an electronic article surveillance tag.

Claim 15 thus includes limitations similar to those discussed above with respect to claim 8. Claim 15 includes the additional limitation that a memory includes instructions

directing a processor to allow deactivation of an EAS tag.

2. The Proposed Combination Cannot Arrive at the Claimed Invention

The limitation of “allowing” deactivation is similar to the limitation discussed above with respect to claim 1. However, there is no limitation in claim 15 that a “consumer” be allowed to deactivate the tag. Nonetheless, the proposed combination cannot arrive at the invention of claim 15

As discussed above, when an EAS tag is detected by the device of Bergman, the microprocessor in the device automatically proceeds to a deactivation process. (Bergman at column 3, lines 12-15, FIG. 3). As stated in Bergman, “[u]pon an affirmative (Y) answer, progress is to step S3, IMPLEMENT DEACTIVATION, and the microprocessor initiates tag deactivation by signal provided on line 20 of Fig. 1.” (Id. at column 3, lines 13-15). Accordingly, the processor is not directed to *allow deactivation* of a tag, the processor is *commanded to deactivate* the tag. Obviously, causing a processor to permit an action is not the same thing as causing a processor to perform an action. There is simply no disclosure in Bergman of *allowing* deactivation.

Accordingly, the proposed combination of Swartz and Bergman does not arrive at Appellants' invention of claim 15. Thus, the proposed combination of Swartz and Bergman does not establish a *prima facie* case of obviousness under 35 U.S.C. § 103 with regard to the invention defined in claim 15. As a result, claim 15 is allowable over Swartz and Bergman. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 15.

3. Conclusion as to Claim 15

Therefore, for all of the above reasons, as well as the reasons set forth with respect to claim 8 above, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 15.

Discussion re: Patentability of Claims 16 and 20

Claim 16 also stands rejected as allegedly being obvious over Swartz in view of Bergman and in further view of Bellis. Claim 20 stands rejected as allegedly being obvious over Swartz in view of Bergman and in further view of Garber. Claims 16 and 20 depend from and incorporate all of the limitations of claim 15. Accordingly, for at least the same reasons as those set forth above in connection with claim 15, it is respectfully submitted that claims 16 and 20 are patentable over the prior art. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claims 16 and 20.

Seventh Claim Grouping: Claims 17-19 are Not Unpatentable Over the Prior Art

Discussion re: Patentability of Claim 17

1. Claim 17

Claim 17 stands rejected as allegedly being obvious over Swartz in view of Bergman and in further view of Bellis. Claim 17 includes the following limitations:

The self checkout of claim 15, further comprising a second electronic article surveillance detector, and the memory has further program instructions which, when executed by the processor, causes

the processor to determine via the second article surveillance detector whether the electronic article surveillance tag has been deactivated by the electronic article surveillance deactivator.

Claim 17 thus includes all of the limitations of claim 15, and adds a limitation directed to a second EAS detector. The second EAS detector limitation is similar to the limitation discussed above with respect to claim 5. Accordingly, for all the reasons set forth above with respect to claim 15, as well as the reason discussed above specific to claim 5, it is respectfully submitted that claim 17 is patentable over the prior art. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claim 17.

Discussion re: Patentability of Claims 18-19

Claims 18-19 also stand rejected as allegedly being obvious Swartz in view of Bergman and in further view of Bellis. Claims 18-19 depend from and incorporate all of the limitations of claim 17. Accordingly, for at least the same reasons as those set forth above in connection with claim 17, it is respectfully submitted that claims 18-19 are patentable over the prior art. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claims 18-19.

(9) CONCLUSION

For all of the foregoing reasons, claims 1-20 are not unpatentable under 35 U.S.C. § 103(a). As a consequence, the Board of Appeals is respectfully requested to reverse the rejection of these claims.

Respectfully submitted,
MAGINOT, MOORE & BECK LLP



James D. Wood
Attorney for Applicants
Attorney Registration No. 43,285

May 17, 2004

Maginot Moore & Beck LLP
Bank One Tower/Center
111 Monument Circle, Suite 3000
Indianapolis, Indiana 46204-5115
Telephone: (317) 638-2922
Facsimile: (317) 638-2139

CLAIM APPENDIX

1. A method of operating a self-service checkout terminal comprising the steps of:
 - allowing consumer scanning of an item for purchase via a scanner;
 - determining, after successfully scanning the item, whether the item has an active electronic article surveillance tag; and
 - allowing deactivation of the active electronic article surveillance tag by the consumer via an active electronic article surveillance tag deactivator after determining that the item has an electronic article surveillance tag.
2. The method of claim 1, wherein the step of determining whether the item has an active electronic article surveillance tag includes the step of utilizing an electronic article surveillance detector.
3. The method of claim 2, wherein the step of utilizing an electronic article surveillance detector, includes utilizing the electronic article surveillance detector that is associated with the scanner.
4. The method of claim 1, further comprising the step of determining whether the electronic article surveillance tag has been deactivated after the step of allowing deactivation of the active electronic article surveillance tag after determining that the item includes the electronic article surveillance tag.

5. The method of claim 4, wherein the step of determining whether the electronic article surveillance tag has been deactivated includes the step of utilizing a second electronic article surveillance detector.
6. The method of claim 5, wherein the step of utilizing a second electronic article surveillance detector, includes the step of utilizing the second electronic article surveillance detector that is associated with a bagwell of the self checkout.
7. The method of claim 5, wherein the step of utilizing a second electronic article surveillance detector, includes the step of utilizing the second electronic article surveillance detector that is associated with a security scale of the self checkout.
8. A self checkout comprising:
 - a scanner operative to scan an item;
 - an electronic article surveillance detector operative to detect whether a successfully scanned item has an active electronic article surveillance tag; and
 - an electronic article surveillance deactivator operative to deactivate the active electronic article surveillance tag after determining by the electronic article surveillance detector that a scanned item has the active electronic article surveillance tag.
9. The self checkout of claim 8, wherein the electronic article surveillance detector is associated with the scanner.

10. The self checkout of claim 8, further comprising a second electronic article surveillance detector that is operative to determine whether the electronic article surveillance tag has been deactivated by the electronic article surveillance deactivator.
11. The self checkout of claim 10, wherein the second electronic article surveillance detector is associated with a bagwell of the self checkout.
12. The self checkout of claim 10, wherein the second electronic article surveillance detector is associated with a security scale of the self checkout.
13. The self checkout of claim 8, wherein the electronic article surveillance detector comprises a coil and electronic circuitry/logic that is operative to obtain a signal from the coil indicative of the active electronic article surveillance tag.
14. The self checkout of claim 13, wherein the coil and electronic circuitry/logic are modular.
15. A self checkout comprising:
 - a processor;
 - a scanner in communication with the processor;
 - an electronic article surveillance detector in communication with the processor;
 - an electronic article surveillance deactivator; and

a memory in communication with the processor and storing program instructions which, when executed by the processor, causes the processor to: (a) allow scanning of an item for purchase via the scanner, (b) determine, after successful scanning of the item, whether the item has an active electronic article surveillance tag via the electronic article surveillance detector, and (c) allow deactivation of the active electronic article surveillance tag after determining that the item includes an electronic article surveillance tag.

16. The self checkout of claim 15, wherein the electronic article surveillance detector is associated with the scanner.

17. The self checkout of claim 15, further comprising a second electronic article surveillance detector, and the memory has further program instructions which, when executed by the processor, causes the processor to determine via the second article surveillance detector whether the electronic article surveillance tag has been deactivated by the electronic article surveillance deactivator.

18. The self checkout of claim 17, wherein the second electronic article surveillance detector is associated with a bagwell of the self checkout.

19. The self checkout of claim 17, wherein the second electronic article surveillance detector is associated with a security scale of the self checkout.

20. The self checkout of claim 15, wherein the electronic article surveillance detector comprises a coil and electronic circuitry/logic, and the memory has further program instructions which, when executed by the processor, causes the processor to cause the electronic circuitry/logic obtain a signal from the coil indicative of the active electronic article surveillance tag.